

**REMARKS**

The present filing is responsive to the Office Action.

**Summary of the Response**

Claims 1, 7, 20 and 23 have been amended. Claims 2-6, 14-15 and 21 have been canceled. Claims 1, 7-13, 16-20 and 22-23 remain pending in this application. Reexamination and reconsideration of the present application as amended are respectfully requested.

**Claim Rejections Under 35 USC 112**

Claims 1-2, 4, 7-13, 16-19 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 has been amended to address the deficiency noted by the Examiner.

**Claim Rejections Under 35 USC 103**

Claims 1-2, 11-13 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,153,572 ("Caldwell et al.") in view of USPN 5,818,430 ("Heiser"). Claims 7-10, 16-19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,153,572 ("Caldwell et al.") in view USPN 5,844,175 ("Nakanishi et al."). Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,153,572 ("Caldwell et al.") in view of USPN 5,844,175 ("Nakanishi et al.") and further in view USPN 5,818,430 ("Heiser"). These rejections are respectfully traversed.

Claim 4 is Patentable

Applicant notes that the Examiner did not apply prior art rejection to previously presented dependent claim 4 (which depends from claim 2, which in turn depends from claim 1). Claim 4 was included in the 112 rejection based on a deficiency in claim 1. Given the amendment to claim 1 to correct the deficiency, claim 4 should now be patentable over the references of record.

Applicant amended claim 1 to include all the limitations of previously presented claims 2 and 4. Accordingly, claim 1 as amended should now be patentable over the references of record. The amendments to claim 1 merely incorporate the limitations of dependent claims 2 and 4. Accordingly, such amendments should be entered even after the present final action.

Should the Examiner wish to substantively reject claim 1 as amended (previously presented claim 4), the present final action must be withdrawn and the new rejection and the basis in support thereof must be set forth in a separate action, so as to allow Applicant a fair opportunity to adequately respond to the rejection.

Given the patentability of claim 1, all claims dependent therefrom must also be patentable.

Notwithstanding the foregoing, Applicant will specifically address below some of the deficiencies in the cited references.

Rejection of Claims 1-2 and 11-13 and 22 based on Caldwell and Heiser

As acknowledged by the Examiner in the present action, Caldwell does not teach the recited sensing lines. However, that is not the only deficiency in Caldwell. Caldwell also does not disclose a grounding conductor that is conductively coupled to the second substrate, as recited in previously presented claim 4. This fact is apparent from the final action, given the Examiner's further acknowledgment with respect to claim 7. The Examiner acknowledged a further deficiency of Caldwell, in that it does not teach a second conductive layer (of the grounding conductor) on the second substrate on the same side as the second conductive surface (of the grounding conductor), wherein the first and second conductive layers (of the grounding conductor) are conductively coupled. Further, the Examiner appeared to instead rely on Nakanishi in reference to a second conductive layer of the grounding conductor on the second substrate<sup>1</sup>. Accordingly, Caldwell does not teach the recited grounding conductor conductively coupled to the second substrate in claim 1 as amended.

Heiser does not make up for the deficiencies of Caldwell. Heiser does not disclose the recited grounding conductor. Accordingly, even if Heiser can and should somehow be combined with Caldwell, such combination would not obtain the invention recited in claim 1 as amended.

Rejection of Claims 7-10, 16-19 and 21 based on Caldwell and Nakanishi

With the exception of claim 21, the rejected claims 7-10 and 16-19 are all dependent directly or indirectly from claim 1. The deficiencies of Caldwell have been discussed above. For claim 7, the Examiner acknowledged a further deficiency of Caldwell. In particular, it does

<sup>1</sup> As noted earlier, the Examiner did not apply any prior art rejection for claim 4 (i.e., the grounding conductor conductively coupled to the second substrate). As will be noted below, Nakanishi is not effective to teach such recited grounding conductor.

not teach a second conductive layer (of the grounding conductor) on the second substrate, wherein the first and second conductive layers (of the grounding conductor) are conductively coupled. The Examiner instead relied on Nakanishi, even though claim 7 is dependent on previously presented claim 4, which was in turn dependent on previously presented claim 1. Applicant does not understand how the Examiner can reject previously presented claim 1 based on a combination of Caldwell and Heiser, but not rely on Heiser for dependent claim 7. Such discrepancy is an indication that the Examiner is encountering difficulties in attempting to find corresponding structures in the cited references to arrive at a combination to render claim 7 obvious, which difficulties are further explained below.

Nakanishi does not make up for the deficiencies of Caldwell. The Examiner has not pointed out if and how Nakanishi teach the missing teachings of Caldwell, including the missing sensing lines, and the missing grounding conductor conductively coupled to the second substrate, and in particular the missing second conductive layer of the grounding conductor on the second substrate. The Examiner referred to the transparent conductive films 3a and 3b in Nakanishi to correspond to the recited first and second conductive layers of the grounding conductor. However, the transparent conductive films 3a and 3b are not conductively coupled (on a permanent basis in the context of claim 1) to form a grounding conductor, as required by claim 7, 4 and 1. The transparent conductive films 3a and 3b comes in to contact only when the touch panel is being activated by a user.

Further, if such transparent conductive films 3a and 3b correspond to the recited grounding conductor, then the Examiner failed to teach where in Nakanishi are separate and distinct conductive surfaces on the first and second substrates which are required of a touch panel. It is clear that the transparent conductive films 3a and 3b are not conductive layers that

are part of a grounding conductor, which are conductively insulated from sensing lines and first and second conductive surfaces, as required by claim 1 from which claim 7 depends. The transparent conductive films 3a and 3b are required by Nakanishi to be the active electrodes for the touch panel, not for grounding static electricity, even though one of the conductive films 3a and 3b is providing with a voltage at ground potential. Such ground potential is merely a reference potential, e.g., at 0V, but it does not mean that such potential node is grounding for the system. It is well accepted that a reference should not be construed for a certain teaching, in a manner that would render the disclose device inoperable. Here, to construe the conductive films 3a and 3b to make up a grounding conductor would render Nakanishi inoperable. Contrary to the Examiner's contention, under a reason and fair reading of Nakanishi within its four corners, the transparent conductive films 3a and 3b at most correspond to the conductive surfaces within the active area of the touch panel, since the transparent conductive films 3a and 3b spans the entire area of the lower and upper substrates 1 and 2 in Nakanishi. There is no separate and distinct structure corresponding to a grounding conductor, which grounding conductor is insulated from the sensing lines and the first and second conductive surfaces, as recited in claim 7 (which incorporates claim 1).

The deficiency of Nakanishi in failing to disclose the recited grounding conductor is evident also from the previous office action, in which Nakanishi was never applied to reject the subject matter of claim 4 (i.e., the grounding conductor conductively coupled to the second substrate).

Accordingly, given all the above, even if Nakanishi can and should be somehow combined with Caldwell, such combination would not obtain the claimed invention.

Still further, there is no teaching, motivation, suggestion or apparent reason to combine Caldwell and Nakanishi in the first place. As noted above, Caldwell is not directed to a touch panel having two opposing substrates with internally facing conductive surfaces. Instead, Caldwell is directed to a touch panel having user input touch pads on the top surface, which interacts with pads underlying the substrate. However, Nakanishi discloses a dual substrate type touch panel. The two different types of touch panels would render it not obvious to one skill in the art to refer to Caldwell, and then Nakanishi, for teaching to form the recited touch panel that requires two substrates supporting two conductive surfaces in the active area.

#### Claim Rejections Under 35 USC 102

Claim 20 is rejected under 35 U.S.C. 102(b) as being unpatentable over USPN 5,153,572 (Caldwell et al.). This rejection is respectfully traversed.

Claim 20 has been amended to incorporate all the limitations in dependent claim 21. Claim 20 as amended recites a grounding conductor conductively coupled to the contact sensitive panel and configured to be conductively coupled to an external ground, wherein the grounding conductor comprises a first conductive layer on the first substrate on the same side as and insulated from the first conductive surface; and a second substrate having a second conductive surface facing the first conductive surface, wherein the grounding conductor comprises a second conductive layer on the second substrate on the same side as and insulated from the second conductive surface.

The arguments presented above with respect to the group of claims led by claim 1 are equally applicable here. In particular, Caldwell does not teach a grounding conductor conductively coupling between the first and second substrate, and in particular first and second

conductive layers on the first and second substrates, which conductive layers (of the grounding conductor) are insulated from the first and second conductive surfaces (which together define the active area).

The amendments to claim 20 merely incorporate the limitations of dependent claim 21. Accordingly, such amendments should be entered even after the present final action. Should the Examiner wish to substantively reject claim 20 as amended (previously presented claim 21), the present final action must be withdrawn and the new rejection and the basis in support thereof must be set forth in a separate action, so as to allow Applicant a fair opportunity to adequately respond to the rejection.

Given the patentability of claim 20, all claims dependent therefrom must also be patentable.

Rejection of Claim 23 based on Caldwell, Nakanishi and Heiser

The rejection of claim 23 is traversed, given the patentability of claim 20 as demonstrated above.

**CONCLUSION**

In view of all the foregoing, Applicant submits that the claims pending in this application are patentable over the references of record and are in condition for allowance. Such action at an early date is earnestly solicited. **The Examiner is invited to call the undersigned representative to discuss any outstanding issues that may not have been adequately addressed in this response.**

The Assistant Commissioner is hereby authorized to charge any additional fees under 37 C.F.R. §§ 1.16 and 1.17 that may be required by this transmittal and associated documents, or to credit any overpayment to **Deposit Account No. 501288** referencing the attorney docket number of this application.

Respectfully submitted,

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